

Appl. No. 09/886,589
Amdt. dated June 26, 2003
Reply to Office Action of March 26, 2003

REMARKS/ARGUMENTS

Claims 1 to 24 are presented for Examiner Pratt's consideration. Claims 1, 3, 5 and 15 have been amended and new claims 21 – 24 have been added. No claims have been canceled.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1 – 20 were rejected under the judicially created doctrine of obviousness - type double patenting as being unpatentable over claims 1 - 21 and 1 - 18 of U.S. Patent numbers 6,162,961, issued to Tanner et al., and 6,296,929 B1, issued to Gentile et al. The Examiner stated that although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same subject matter. The Examiner also stated that with respect to U.S. Patent 6,162,961, the instant application claims a narrower density range; however, U.S. Patent 6,162,961 encompasses the claimed range. U.S. Patent 6,162,961 lacks the language "exhibiting exceptional expansion properties," but it is the Examiner's position that this feature is inherent in U.S. Patent 6,162,961. The Examiner further stated that U.S. Patent 6,296,929 utilizes the closed transitional language "consisting" while the instant application utilizes the open transitional language "comprising."

Applicant is hereby filing a timely Terminal Disclaimer in compliance with 37 C.F.R. 1.321 (c) to overcome any actual or provisional rejection based on a non-statutory double-patenting ground since the present application and the two issued patents are commonly owned by Kimberly-Clark Corporation. Based upon the filing of this Terminal Disclaimer, Applicants believe that this objection is satisfied.

By way of the Office Action mailed March 26, 2003, Examiner Pratt rejected claims 1 – 20 under 35 U.S.C. § 112, first paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner states that all of the claims contain the phrase "exceptional expansion properties" and considers this phrase to be indefinite because this is a relative term. On June 9, 2003, inventor James Tanner and his patent attorney, Thomas Connelly, traveled to the USPTO and met with Examiner Pratt and Primary Examiner Cheryl Juska. At this meeting a video was shown featuring the ability of Applicants' absorbent member to take up a quantity of synthetic blood versus the Hansen et al patent (U.S. 5,998,032). A live demonstration of the ability of Applicants' absorbent member to take up water was also shown. After this demonstration, both Examiner Pratt and Primary Examiner Juska agreed that Applicants' absorbent member did exhibit "exceptional expansion properties" and that the use of

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this phrase in the claims was acceptable. In view of the Examiners' comments, this rejection should be withdrawn.

By way of the Office Action mailed March 26, 2003, Examiner Pratt rejected claims 1 – 20 under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over Hansen et al., Patent number 5,998,032. This rejection is respectfully **traversed** to the extent that it may apply to the presently presented claims.

As mentioned above, inventor James Tanner and his attorney, Thomas Connelly, conducted an interview with Examiner Pratt and Primary Examiner Juska on June 9, 2003. At this interview, Applicant showed a videotape made of a demonstration of fibers made according to the Hansen et al. patent and fibers made according to the present invention. The Hansen patent is concerned with the uptake of synthetic blood. The Hansen patent teaches fibers bonded to superabsorbent particles. It also talks about hydrogen bonds which are formed between the fibers and the superabsorbent particles. Hansen does not disclose fiber-to-fiber hydrogen bonds. The Hansen patent is directed to the uptake of synthetic blood versus a less viscous aqueous material such as water. In the demonstration, it was obvious that Hansen had a lesser affinity for absorbing water than blood. Applicants' absorbent materials exhibited a greater affinity for absorbing water because the fibers are secured to other fibers by hydrogen bonds. Applicants' absorbent material does not contain any superabsorbent particles. Based upon the demonstration, it was agreed by both Examiners that a different functionality was present and, according to the interview summary signed by Examiner Pratt, Applicants' invention is distinguishable over Hansen in three distinct ways. First, Hansen fails to teach fiber-to-fiber hydrogen bonds. Second, Hansen compacts his fibers at a low compression factor and those skilled in the art would not be motivated to further compact the fibers. Further contraction would destroy the functionality of Hansen's fibers to absorb blood. Third, Applicants' invention differs functionally in its ability to absorb water versus blood. In Applicants' invention, the water breaks the hydrogen bonds formed between the fibers and allows for exceptional expansion of the fibers.

Examiner Pratt has further stated that Applicants' compression factor of 20 or above, taught in the specification on page 7, lines 24 – 31, is not taught by the Hansen patent. Based upon these differences, Applicants have amended independent claim 1 to recite a compression factor of at least about 20 versus 5, which was the initial value. Basis for this language appears in the specification on page 7, lines 25 and 26. Applicants have also amended dependent claim 3 to recite that the compression factor is 33 versus 20. Basis for this compression factor is taught in the specification on page 7, lines 29 – 31.

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Applicants have amended claim 5 in a similar fashion as claim 1, such that the compression factor is now at least about 20.

Applicants have also amended independent claim 15 to recite that the fibers are bonded to other fibers by hydrogen bonds. Basis for this language appears in the specification on page 8, lines 23 – 27.

In addition to the above amendment, Applicants have added four new independent claims. Claim 21 is identical to the original claim 1, plus the added feature that the fibers are bonded to other fibers by a hydrogen bond. Claim 22 is identical to original claim 5, plus the fact that the fibers are bonded to other fibers by hydrogen bond. Claim 23 is identical to original claim 10, plus the fact that the fibers are bonded to other fibers by hydrogen bond and the compression factor has been changed from 20 to 33. Lastly, claim 24 is identical to original claim 15, plus the added language that the fibers are bonded to other fibers by a hydrogen bond and the compression factor has been changed from 5 to 33.

In view of the above amendments and new claims, Applicants believe that the amended claims 1, 3, 5 and 15 all recite a compression factor much greater than that taught in the Hansen patent. Accordingly, these claims are patentably distinguishable over the cited prior art. The new claims 21 – 24 teach bonding fibers-to-fibers by hydrogen bonds. This feature is not taught in Hansen. Hansen specifically states that the fibers are bonded to the superabsorbent particles by the hydrogen bonds. Accordingly, Applicants believe that the amended claims 1, 3, 5 and 15, along with original claims 2, 4, 6 – 14 and 16 – 20, and new claims 21 – 24 are patentably distinguishable over Hansen and should be allowed at this time.

For the reasons stated above, it is respectfully submitted that all of the presently presented claims 1 - 24 are in form for allowance.

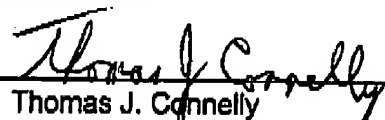
Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-2455.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE

I, Lanette Burton, hereby certify that on June 26, 2003, the aforementioned documents are being transmitted via facsimile to the United States Patent and Trademark Office, Alexandria, VA to Right Fax number 703-872-9310.

By: Lanette Burton
Lanette Burton